

REMARKS

Claims 1-21 are pending in the present application. No claims have been amended or canceled. Applicant respectfully requests reconsideration and examination in view of the following remarks.

Substance of Interview Summary

A telephonic interview occurred between the undersigned, Murrell Blackburn and Examiner Eugene Yun on Thursday, April 22, 2004. The interview covered the rejections to claims 1-21 under 35 U.S.C. 103(a) as being unpatentable over Schornack et al (US 5,946,616, hereinafter "Schornack") in view of Morrow (US 6,498,938, hereinafter "Morrow").

New arguments and proposed amendments were discussed. The Examiner indicated that the proposed amendment including "two conductors" would not be approved without clear support from the specification due to the introduction of new matter. With regard to arguments that the Morrow reference renders Schornack unsatisfactory for its intended purpose and that the references teach away from their combination, the Examiner understood the arguments but desires to wait until a written response is filed before deciding on persuasiveness.

This written response is thus, submitted in follow-up to the telephonic interviews for consideration by the Examiner, as it is believed to have placed the application in condition for allowance.

Claim Rejections – 35 U.S.C. § 103

As stated above, claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Schornack in view of Morrow. Applicant respectfully traverses this rejection on the grounds that the references Schornack and Morrow are improperly combined and there is no suggestion or motivation to make the proposed modification as outlined in the MPEP sections 2143.01 and 2145 X ((D)(2)).

The Office Action acknowledges that "Schornack does not teach one or more wired telephones directly connected to said wired home telephone network "(see page 4, line 3 of Office Action). However, the Office Action asserts that Morrow resolves the deficiencies of Schornack by teaching a wired telephone directly connected to said wired home telephone network, stating that "it would have been obvious to provide the teachings of Morrow to said device of Schornack in order to better combine the mobility of a cellular phone with the

connectivity of a wired phone system. Applicant respectfully traverses this assertion and submits that the proposed modification of Morrow to Schornack renders Schornack unsatisfactory for its intended purpose and changes the principle of operation of Schornack.

As recited in Schornack, "the invention is simultaneously connected to both wireline and cellular services" (Column 4, lines 9-11). Schornack requires a line inversion adapter to connect a wired phone to both a wireline and a cellular network. A phone without an adapter in Schornack is dedicated to the wireline network. (Column 4, lines 19-32). Modifying Schornack with a phone without an adapter would dedicate the phone to the wireline network unless the interface of Morrow is included. However, including the interface of Morrow would also render the intended purpose of Schornack unsatisfactory for its intended purpose. The invention of Schornack can receive and send calls on the wireline network even when the cellular network is connected and operative. (See Schornack column 5, lines 1-21) When the invention as disclosed in Morrow has a wireless unit connected, signal transmissions from the wireline network are not permitted. (See Morrow column 4, lines 23-28). Thus, Schornack modified by Morrow, with the directly connected phone and/or the interface of Morrow, would be rendered unsatisfactory for Schornack's intended purpose and would change the principle of operation of Schornack as recited in column 5, lines 1-21 of Schornack.

The MPEP states in section 2143.01 "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The MPEP also states in section 2143.01, " If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." Further, in section 2145 X ((D(2)), the MPEP supports that Schornack and Morrow cannot be combined because they teach away from their combination.

Weighing the suggestive power of each reference, Schornack discredits the use of a direct connection between the phone and the home telephone network as disclosed in Morrow. Morrow discredits the simultaneous connection and operation of both the wireline and cellular networks as disclosed in Schornack. Thus, Applicant respectfully asserts that it would not have been obvious to one of ordinary skill in the art at the time of the invention was made to provide

the teachings of Morrow to said device of Schornack. Accordingly, Applicant also submits that claims 1-21 are allowable over Schornack.

**Conclusion**

In view of the above remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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